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10/566,563

08/28/2006

Karsten Bohnisch

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05/22/2009

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
500 W. MADISON STREET
SUITE 3800
CHICAGO, IL 60661

EXAMINER

NICHOLS II, ROBERT K

ART UNIT

PAPER NUMBER

3754

MAIL DATE

DELIVERY MODE

05/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---|--|--|
| Office Action Summary | Application No. 10/566,563 | Applicant(s) BOHNISCH ET AL. | |
| | Examiner ROBERT K. NICHOLS II | Art Unit 3754 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/28/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/31/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Amendment

The preliminary amendment filed on 01/31/2006 has been entered.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the inner hole rim" in line 28. There is insufficient antecedent basis for this limitation in the claim.

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Claim 3 recites the limitation "annular washer" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "washer" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 6 and 7 recite the limitation "the bag" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia (EP 1 050 481), in view of Privas (US 5,417,258).

Regarding claims 1, 2 and 9, Garcia discloses a dispenser pack including a metering pump 14 and a container 24 that is tightly connected to the metering pump 14 and that can be ventilated by the pump (see figure 2 and paragraphs 13-14). Garcia discloses a closing cap 130 that can be attached to a neck 32 of the container 24, as well as a cylindrical wall 190 that encloses an axial aperture 192 that is arranged above an internal flange 196; a retainer 140 for attaching the pump 14 within the aperture 192 of the closing cap 130, wherein an exterior flange of the retainer 140 can be pressed against an annular seal 132 on an

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outer face of the container neck 32 so as to be sealed by the closing cap 130; a pump housing including a pump cylinder 141 that surrounds a pump chamber whose upper end includes an aperture and whose lower end includes a suction pipe nipple freely exposed (see figures 2 and 3); and a piston shaft 148 which protrudes outward from the pump chamber and at its outer end includes an activation- and dispensing head 16 (see figure 2). Garcia further discloses that the volume of the container 24 that contains the free-flowing medium can be adjusted to the decrease of the volume of the free-flowing medium to be dispensed from the container 24; and a inner hole rim of the seal 132 forms an annular lip between the face of the container neck 32 and the exterior flange of the retainer 140 rests against the outside of the pump housing 141 so as to be airtight (see figures 1 and 3, and paragraphs 16 and 21).

Regarding claim 8, Garcia discloses the container 24 including a cylindrical internal wall and is open at the bottom end into which a drag-flow piston 29 is inserted so that it is axially movable and seals off the internal wall of the container 24, wherein the drag-flow piston 29, depending on the quantity of medium dispensed and depending on the suction pressure exerted on the medium, is slidable in the direction of the pump 14 (see figure 1 and paragraph 16).

With further respect to claim 1, Garcia discloses all the elements of the claimed invention but is silent to the teaching of the inner structure of the pump.

Privas teaches a dispenser pack including a metering pump 7, including a pump housing having a pump cylinder 7 that surrounds a pump chamber 16; a

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pump piston 15 which is arranged in the pump chamber 16 so as to be slidable in a sealed manner, and includes a piston shaft 9 which protrudes outward from the pump chamber 16 and at its outer end comprises an activation- and dispensing head; an axial outlet channel that extends through the piston shaft 9 and the pump piston 15 and connects the pump chamber 16 to a dispensing aperture of the activation head; an inlet valve 17 and an outlet valve 19 for the free-flowing medium; and a helical compression spring which impinges on the pump piston 15 in the direction of its home position (see figures 2, 3 and 21, and column 7, lines 48-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention to construct the pump of Garcia to include inner structure, as taught by Privas, in order to extract fluid product from the container.

Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia (EP 1 050 481) and Privas (US 5,417,258) as applied to claims 1, 2, 8 and 9 above, further in view of Nomoto et al. (US 6,266,943).

Regarding claims 3-6, the combination of Garcia and Privas disclose all the elements of the claimed invention except the medium within the container being enclosed by a flexible bag and the seal being in the form of a truncated cone, wherein the thickness is reduced towards the outer end of the annular lip.

Nomoto teaches a dispenser pack wherein medium within a container 401 is enclosed by a bag 402 made of a flexible material, with the upper aperture rim of the bag 402 being tightly connected to the wall of the container 401, while in a

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space 408 between the inside of the container wall and the outside of the bag

402 air at atmospheric pressure is contained (see column 24, lines 14-29).

Nomoto discloses the bag and container being formed in one piece (see column 24, lines 10-13). Nomoto further discloses an annular seal (F) on an outer face of the container neck 405, wherein the thickness of the seal is reduced towards the outer end of an annular lip 435a (fig 36). Nomoto discloses the seal (F) pressed radially inward in the form of a truncated cone across an annular space against the cylindrical outside of the pump housing in order to provide tight seal, capable of releasing compressed air, when the inner pressure of the container (D) rises after pump installation (see figures 36, 37 and column 31, lines 34-56).

Therefore, a person of ordinary skill has good reasons to pursue the known options or finite number of solutions, i.e. a container including a flexible bag, as suggested by Nomoto, or a container including a follower piston, for the predictable result of providing a container whose interior volume reduces in conjunction with the dispensing of the product, since the finite number of options are within the technical grasp of a person of ordinary skill in the art.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the device of the combination of Garcia and Privas with a seal being in the form of a truncated cone, wherein the thickness is reduced towards the outer end of the annular lip, as taught by Nomoto, in order to provide tight seal, capable of releasing compressed air, when the inner pressure of the container rises after pump installation.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia (EP 1 050 481) and Privas (US 5,417,258) as applied to claims 1, 2, 8 and 9 above, further in view of Rebeyrolle et al. (US 5,031,384).

Regarding claims 6 and 7, the combination of Garcia and Privas discloses all the elements of the claimed invention except the medium within the container being enclosed by a flexible bag and the aperture rim of the bag being injection-moulded to the bottom end of the container neck.

Rebeyrolle teaches a dispenser pack 8 wherein medium within a container is enclosed by a bag or pouch 4 made of a flexible material. Rebeyrolle discloses the bag 4 and the container being formed in one piece wherein the aperture rim of the bag 4 is moulded to the bottom end of the container neck (see figure 1 and column 6, lines 40-65).

Therefore, a person of ordinary skill has good reasons to pursue the known options or finite number of solutions, i.e. a container including a flexible bag, as suggested by Rebeyrolle, or a container including a follower piston, for the predictable result of providing a container whose interior volume reduces in conjunction with the dispensing of the product, since the finite number of options are within the technical grasp of a person of ordinary skill in the art.

Furthermore, it is noted the patentability of a product does not depend on its method of production. If the product in the product-by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even

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though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698,227 USPQ 964,966 (Fed. Cir. 1985)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Meshberg (US 4,008,830), Decottignies et al. (US 6,510,965), Stone (US 4,322,020) and Gueret (US 5,292,033) show other devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT K. NICHOLS II whose telephone number is (571)270-5312. The examiner can normally be reached on Mon-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. K. N./
Examiner, Art Unit 3754

/Kevin P. Shaver/
Supervisory Patent Examiner, Art
Unit 3754